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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/975,831	10/11/2001	Kamal Acharya	NETS0085	3000

22862 7590 08/23/2005

GLENN PATENT GROUP
3475 EDISON WAY, SUITE L
MENLO PARK, CA 94025

EXAMINER

RHODE JR, ROBERT E

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 08/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/975,831	Applicant(s) ACHARYA ET AL.	
	Examiner Rob Rhode	Art Unit 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3 and 6 - 25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3 and 6 - 25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10-4-2004 has been entered.

Response to Amendment

Applicant amendment of 10-4-04 amended claims 1, and 22 – 23 and canceled claims 2 and 4 - 5 as well as traversed rejections of Claims 1, 3 and 6 - 25.

Currently, claims 1, 3 and 6 - 25 are pending.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 1 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts. The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Moreover, the courts have found that a claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer. See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). Finally, the Board of Patent Appeals and Interferences (BPAI) has recently affirmed a §101 rejection finding the claimed invention to be non-statutory based on a lack of technology. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

Mere intended or nominal use of a component, albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea if the component does not apply, involve, use, or advance the underlying process.

In the present case, the Applicant only has a nominal recitation of technology such as online, the claim does not incorporate technology in carrying out the recited steps.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 3, 6 - 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pricescan (PTO-892, Ref U) in view of Portman (US 2002/0160766 A1).

Referring to claim 1 and related claims 22 and 23, Pricescan discloses a method and system for providing an integrated electronic list of providers (page 3), comprising the steps of

determining at least one online provider for an item (page 4, "Does a vendor need to have a web site to be included in the shopping guide");

determining at least one offline provider for the item (page 4, "Does a vendor need to have a web site to be included in the shopping guide");

wherein the determining step follows a request for a product (page 10);

and

integrating the at least one online provider with the at least one offline provider to provide an integrated list of providers for the item (page 4, "Does a vendor need to have a web site to be included in the shopping guide").

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However, Pricescan does not specifically disclose and teach a method and system wherein when the request is for a desired geographical area, a user may choose one of several target locations, which have been previously created and stored; wherein the request is for a predetermined proximity to a target location, the user may choose a radius for said target location.

On the other hand and in the same area of providing a list of providers, Portman teaches a method and system Wherein when the request is for a desired geographical area, a user may choose one of several target locations, which have been previously created and stored; wherein the request is for a predetermined proximity to a target location, the user may choose a radius for said target location (see at least Para 0008, 0041, 0043, 0048 and 0070).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the method and system of Pricescan with the method and system of Portman to have enabled the method as recited in claim 1. Pricescan discloses a method and system for providing an integrated electronic list of providers, comprising the steps of determining at least one online provider for an item (page 4, determining at least one offline provider for the item (page 4, wherein the determining step follows a request for a product and integrating the at least one online provider with the at least one offline provider to provide an integrated list of providers for the item (see at least page 4, "Does a vendor need to have a web site to be included in the shopping guide").

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In turn, Portman teaches a method and system wherein when the request is for a desired geographical area, a user may choose one of several target locations, which have been previously created and stored; wherein the request is for a predetermined proximity to a target location, the user may choose a radius for said target location (see at least Para 0008, 0041, 0043, 0048 and 0070). Therefore, one of ordinary skill in the art would have been motivated to extend the method and system of Pricescan with a method and system wherein when the request is for a desired geographical area, a user may choose one of several target locations, which have been previously created and stored; wherein the request is for a predetermined proximity to a target location, the user may choose a radius for said target location. Thereby, the user can receive both comparison-shopping with geographic area of interest, which will ease the number of task to accomplish manually to effect saving money both on the product and the driving time for the user

Referring to claim 3, Pricescan further discloses a method wherein the request is for a product category (page 3)

Referring to claim 6, Pricescan further discloses a method including providing comparison information for the at least one online provider and the at least one offline provider (page 3 - page 5).

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Referring to claims 7 –13 Pricescan further discloses a method wherein the comparison information includes price, rating, review, availability, promotion, electronic wallet, and return-policy comparison (full text).

Referring to claim 14, Pricescan further discloses a method providing comparison information about at least two off line providers (page 4).

Referring to claims 15 -16, Pricescan further discloses a method wherein the comparison information includes in-store return policy and in-store pickup policy of online purchases (page 4).

Referring to claims 17 – 18, Pricescan further discloses a method wherein the comparison information includes special promotions and coupon-availability information (page 4).

Referring to claims 19 – 20, Pricescan in view of Portman discloses a method according to claim 14 as indicated supra. Pricescan does not expressly disclose a method wherein the comparison information includes proximity and direction to the at least two offline providers. Portman discloses a method wherein the comparison information includes proximity and direction to the at least two offline providers (abstract). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified the apparatus, system, and method of Pricescan to include the limitations

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Portman as discussed above in order to allow the consumer to save money and help take the hassle out of shopping (Pricescan: Page 3).

Referring to claim 21, Pricescan further discloses a method wherein the comparison information includes user review (page 12).

Referring to claim 24, Pricescan further discloses a computer system implement on a network environment (full text).

Referring to claim 25, Pricescan further discloses a computer system wherein the network environment further comprising a global communications network (full text).

Response to Arguments

Applicant's arguments with respect to claims 1, 3 and 6-25 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art is Treyz (US 6,587,835 B1), which discloses that online comparison shopping with geographical location was old and well known at the time of the applicant's invention.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Rob Rhode** whose telephone number is **571.272.6761**.

The examiner can normally be reached Monday thru Friday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Wynn Coggins** can be reached on **571.272.7159**.

Any response to this action should be mailed to:

Commissioner for Patents

P.O. Box 1450

Alexandria, Va. 22313-1450

or faxed to:

571-273-8300

[Official communications; including
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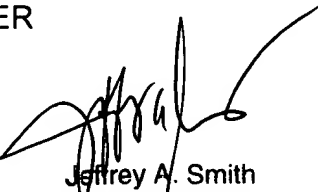
For general questions the receptionist can be reached at

571.272.3600

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Jeffrey A. Smith
Primary Examiner